UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte WINNIE C. DURBIN,
KARAMJEET SINGH,
and KUN ZHANG

Appeal No. 2006-0490
Application 09/681,017[1]

ON BRIEF

Before HAIRSTON, BARRETT, and MacDONALD, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON REQUEST FOR REHEARING

Appellants request rehearing of that part of our decision entered May 9, 2006, in which we sustained the rejection of claims 23-26 as directed to nonstatutory subject matter.

The request for rehearing has been considered, but is denied with respect to making any changes in our decision.

[1] Application for patent filed November 22, 2000, entitled "Method and System to Remotely Enable Software-Based Options for a Trial Period."

DISCUSSION

In our original decision, we sustained the rejection of claims 23-26, to a "computer data signal embodied in a carrier wave," as a "signal" that is nonstatutory subject matter because it does not fall within any of the four classes of eligible subject matter of 35 U.S.C. § 101.

Appellants note that MPEP § 2106(IV)(B)(1)(c) states that "a signal claim directed to a practical application of electromagnetic energy is statutory regardless of its transitory nature." It is argued that "[t]he Board disregards this section of the MPEP by stating that '"[s]ignals" not embodied in a tangible medium' are non-statutory" (Request Reh'g at 2) and "the fact that the carrier wave of claim 23 'is not a computer readable medium as it is not persistent' is irrelevant to patentability under § 101 as explained in MPEP § 2106(IV)(B)(1)(c)" (id.). It is argued that claim 23 is patentable under § 101 because it calls for a signal directed to a practical application that "causes the at least one processor to enable an option in a device" (Request Reh'g at 2-3).

The MPEP is a manual of examining procedure and is not controlling as to matters of law. Moreover, the present position of the Office is that "signals" are not statutory subject matter. See analysis in U.S. Patent and Trademark Office's Interim Guidelines for Examination of Patent Applications for Patent

Subject Matter Eligibility, 1300 Off. Gaz. Patent and Trademark Office 142, 152 (Nov. 22, 2005). Appellants have not addressed or shown any error in the reasoning in our decision that a "signal" does not fall within any of the classes of § 101. It is noted that the issue of whether a "signal" is statutory subject matter is presently on appeal to the Federal Circuit in In re Nuijten, No. 06-1301.

Appellants argue that claims in other patents are directed to "signals," which shows the propriety of claims to a computer data signal (Request Reh'g at 3-4).

The issuance of a patent has no precedential value. See In re Riddle, 438 F.2d 618, 620, 169 USPQ 45, 47 (CCPA 1971) ("two wrongs cannot make a right"); Ex parte Tayama, 24 USPQ2d 1614, 1618 (Bd. Pat. App. & Int. 1992).

CONCLUSION

The request for rehearing has been considered, but is denied with respect to making any changes in our decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2004).

DENIED

KENNETH W. HAIRSTON
Administrative Patent Judge

LEE E. BARRETT
Administrative Patent Judge

ALLEN R. MacDONALD
Administrative Patent Judge

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